

Appl. No.: 10/626,281
Amendment dated May 2, 2005
Reply to Office Action of November 1, 2004

REMARKS/ARGUMENTS

Claims 1-15, 17-40 are currently pending in this case.

Amendment To The Claims

The claims are amended in the above Listing of Claims to amend pending claims 1, 4, 6, 7, 12-15, 17-24, 33 and 35, and to cancel pending claim 16. The amendment of the claims adds no new matter. An explanation of the amendments is given below:

The preamble of claim 1 is amended to identify the object of the process. Step (b) of claim 1 is amended to incorporate the process of canceled claim 16 and to identify the solvent as a "crystallization solvent".

Claims 4, 6, 7, 12-15, 23 and 24 are amended to change "comprises" to "is", as suggested by the examiner.

Claim 17 is amended to change "comprises" to "is by", as suggested by the examiner.

Claims 18-23 are amended to change the dependency to claim 1 and to identify the solvent as the "crystallization solvent".

The preamble of claim 33 and 35 is amended to identify the object of the process.

Entry of the amendments to the claims is believed to be appropriate and is respectfully requested.

Rejection of Pending Claims 1-40 Under 35 USC § 112, Paragraph Two

The Examiner rejects independent claims 1 and 33-35 as being "written in functional language and therefore broader than the enabling disclosure." Applicants respectfully traverse this rejection for three reasons. First, the wording of the claims comes from the disclosure and is,

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therefore, of the same breadth as the disclosure. Second, process language is inherently functional. Third, it is not the function of the claims to set out the detail of carrying out the invention, only to define the metes and bounds of the ensuing patent protection. In the independent claims, applicants are claiming the invention in broad terms which they deem to be patentable. The examiner appears to be attempting to judge the "critical elements" of applicants' claims before applying the prior art.

Claim 1 is amended above to direct the "purifying" to crystallization.

For these reasons, withdrawal of the rejection of claim 1 and 33-35 and continued examination based on claims 1 and 33-35, as amended, is respectfully solicited.

Claims 4, 6-8, 10, 12-15, 18-19, 21, 23-24, 26-27, 29 and 31 are stated to be indefinite because the word "comprise" makes the claim indefinite and should be changed to "is" (or "is by" for claim 17). Applicants respectfully traverse this rejection because "comprises" is well understood and means what the examiner thinks it means, namely, that other things may be included with the "comprising" item. Thus, in claims 8, 10, 18, 19, 21, 26, 27, 29 and 31 Applicants have not changed "comprises" to "is" as suggested by the examiner. In claim 8, for example, the phrase is: "wherein the tocopherol compound comprises α -tocopherol". This wording means that α -tocopherol must be present, but other tocopherols could also be present. The following claim 9 states that " α -tocopherol makes up at least about 80% based on weight of the tocopherols". If, in claim 8, Applicants wanted α -tocopherol as the only tocopherol compound to be present in the infringing process, then they would have used "is", as the examiner suggests. It is perfectly acceptable for applicants to state the claim in such broader language as long as it is patentable over the prior art.

On the other hand, Applicants have deemed it appropriate to amend claims 4, 6, 7, 12-15, 23 and 24 to change "comprises" to "is", as suggested by the examiner.

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For these reasons, Applicants respectfully request withdrawal of the rejection of claim 4, 6-8, 10, 12-15, 18-19, 21, 23-24, 26-27, 29 and 31 under 35 USC § 112, paragraph two, and continuing examination of these claims, as amended.

Claim 34 is rejected (under 35 USC § 112, paragraph two) as a substantial duplicate of claim 1. Applicants respectfully request withdrawal of this rejection because claim 34 includes a step (a) starting material which is materially different from that in claim 1, namely, "a tocopherol compound" instead of "a protecting group-substituted tocopherol compound". Thus, the claims are not substantially duplicates.

Claims 38-40 appear to be rejected for two reasons, namely: (1) they are duplicates of claim 36, and (2) they are drawn as product-by-process claims. Applicants respectfully request withdrawal of these rejections. Applicants note that claim 36 is a straight composition claim, whereas claim 38 is drawn to a composition made by the process of claim 1; claim 39 is drawn to a composition made by the process of claim 34, and claim 40 is drawn to a composition made by the process of claim 35. It does not matter that the examiner is supposed to examine some types of product-by-process claims as composition claims. This does not turn such product-by-process claims into composition claims. If found allowable over the prior art composition/process, each one would indeed only cover a composition made by the respective process.

For these reasons applicants respectfully request withdrawal of the rejection of claims 38-40 under 35 USC § 112, paragraph two, and continued examination of these claims.

There are no further rejections in the subject Office Action. It is believed that the foregoing amendments to the claims, remarks and arguments are completely responsive under 35 CFR 1.111 and completely avoid and/or overcome all grounds of rejection. Applicants therefore respectfully request that a timely Notice of Allowance be issued in this application.

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The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,
NORMAN MILSTEIN.

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Enclosure: Request for Extension of Time